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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,770	07/31/2001	Paul Bornstein	UOFW117618	4001
26389	7590	11/23/2004	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			GIBBS, TERRA C	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,770

Applicant(s)

BORNSTEIN ET AL.

Examiner

Terra C. Gibbs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28,32,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28,32,35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This Office Action is a response to Applicants Amendment and Remarks filed September 13, 2004.

Claims 31, 33, and 34 have been canceled. Claims 28 and 32 have been amended. Claims 28, 32, 35, and 36 are pending in the instant application.

Claims 28, 32, 35, and 36 have been examined on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

In the previous Office Action mailed April 20, 2004, claim 28 was rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of decreasing the amount or biological activity of thrombospondin 2 in an animal, said method comprising the step of locally introducing into said animal a medical device comprising an antisense thrombospondin 2 consisting of a nucleic acid antisense nucleic acid that hybridizes to SEQ ID NO:3, does not reasonably provide enablement for a method of decreasing the amount or biological activity of thrombospondin 2 in an animal, said method comprising the step of introducing into said animal a structure comprising an antisense thrombospondin 2 consisting of a nucleic acid antisense nucleic acid that hybridizes to SEQ ID NO:3. **This rejection is withdrawn** in view of Applicants amendment to the claims filed September 13, 2004. Specifically, the Examiner is withdrawing this rejection in view of Applicants amendments to the claims to include a method of *locally* decreasing the amount or biological activity of

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thrombospondin 2 in an animal, and the inclusion of the medical device verbiage in the claims has further persuaded the Examiner to withdraw this rejection.

Claim Rejections - 35 USC § 102

In the previous Office Action mailed April 20, 2004, claim 28 was rejected under 35 U.S.C. 102(e) as being anticipated by Streit et al. [U.S. Publication No: 2002/0119921]. **This rejection is maintained** for the reasons of record set forth in the previous Office Action mailed April 20, 2004. It is noted that in the previous Office Action mailed April 20, 2004, this rejection was only applied to claim 28, however, in the current Office Action, this rejection is applicable to all pending claims, including claims 28, 32, 35, and 36.

Response to Arguments

In response to the rejection, Applicants argue that claim 1 has been amended to recite a method of locally decreasing the amount or biological activity of thrombospondin 2 in an animal, wherein the method includes the step of introducing into an animal a medical device adapted to be affixed to, or implanted within, soft tissue of an animal. Applicants contend that this limitation is neither disclosed nor suggested in the Streit et al. publication. Applicants submit that the Streit et al. publication does not anticipate amended Claim 28.

Applicant's arguments have been fully considered but are not found persuasive because Streit et al. disclose a method of decreasing thrombospondin 2 (TSP-2) activity by administering, antisense thrombospondin 2 nucleic acid molecules, a **TSP-2 antisense** that binds to cellular TSP-2 mRNA and inhibits (decreases) expression of the protein (see page 5 [0049]). Streit et al.

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further disclose the nucleotide sequence of TSP-2 (see Streit et al. SEQ ID NO. 1), which is identical to SEQ ID NOs. 3 of the instant invention. Further, Streit et al. at page 18, [192] disclose that nucleic acids described herein can be delivered to a subject by local administration, and thus meets the limitation of claim 28. Streit et al. at page 1, [007] disclose, "TSP-2 activity can also be increased by controlled delivery to the subject of a TSP-2 nucleic acid, or a TSP-2 protein, fragment, or analog. A TSP-2 nucleic acid, protein, fragment, or analog can be administered to the subject in combination with a controlled release device, e.g., a biocompatible polymer, micro particle, or mesh. The **device** can reduce degradation and control the release of the TSP-2 nucleic acid, protein, fragment, or analog. Such a TSP-2 biocompatible controlled release system can be administered to the subject, e.g., by injection or **implantation** e.g., intramuscularly, subcutaneously, intravenously, or at an organ, joint cavity, or at a lesion", and thus meets the limitations of claims 28 and 32. Streit et al. also disclose at page 10, [0097], "as used herein, the term "subject" refers an animal, e.g., a mammal, e.g., a human", and thus meets the limitations of claims 35 and 36. Therefore, contrary to Applicants arguments, Streit et al. clearly disclose the limitations recited in the instant claims.

Therefore, Streit et al. anticipate claims 28, 32, 35, and 36.

Conclusion

No claims are allowable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terra C. Gibbs whose telephone number is (571) 272-0758. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (571) 272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tcg
November 17, 2004

JOHN L. LE GUYADER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600